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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,092	03/12/2004	Jason P. Snider	CL-23008 (104200-236)	7596

7590

11/15/2006

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Chicago, IL 60606

EXAMINER

DRODGE, JOSEPH W

ART UNIT	PAPER NUMBER
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1723

DATE MAILED: 11/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/799,092

Applicant(s)

SNIDER ET AL.

Examiner

Joseph W. Drodge

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Affadavits of 8/28/2006 are persuasive

The Affidavits of 8/28/2006 are deemed persuasive, proper and adequate and negate the rejection of the claims over Tarrant in view of Holyoak presented in the Office Action of 3-23-2006.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-6 and 9-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koehler et al patent 5,664,628 in view of Underdown PGPUBS Document

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US2003/0079876. For independent claims 1,4,9 and 14, Koehler et al disclose a fluid filter for optionally separating water from oil and other volatile contaminants as well as solid contaminants, position-able downhole in a well (column 4, lines 4-41 and column 8, lines 33-63). The filter comprises a perforated shell or outer covering 20 having open ends (or an upper open end and closed lower end), closed by end caps or plates 18 (column 14, lines 46-58), the upper end plate having an outlet opening means communicating with the well head for removing water and/or oil {as in claim 6} or other volatile fluid (column 18, line 44-column 19, line 28 with column 8, lines 33-63). The filter also comprises a filter media comprising an annular co-pleated member having a plurality, of 3 or more layers, some of which comprising membrane material; an outer layer or layers comprising a metal that is substantially neutral to corrosive products in the fluid, column line discussing the corrosive nature of the well fluids being filtered; the media also optionally containing layers of polymeric or cellulosic material (see column 10, lines 12-58; column 11, line 41-column 13, line 36).

The claims all differ in requiring the upper end plate to have inlet opening means in addition to outlet opening means. However, Underdown teaches a pleated membrane filter that can be positioned in a wellhead for separating water and oil, with oil passing upwards through outlet means in an upper end plate, and there also being an inlet means in the upper end plate for passing backwashing/backflushing fluid into the filter (paragraphs 3, 25-27,29,38 and 39). It would have been obvious to one of ordinary skill in the art to have modified the filter apparatus of Koehler, to include an inlet means in the upper end plate, as taught by Underdown, to enable cleaning of the

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filter media when it becomes clogged by solid contaminants such as sand, to enable it's continued functioning in the well.

Applicant's are advised that although none of the applied prior art specifically addresses "sacrificial neutralization" of corrosive products of a fluid, such language of the instant claims does not correspond to any particular, corresponding apparatus component feature. It is noted that both Koehler and Underdown do disclose filtration of corrosive fluids (see Koehler at column 8, lines 25-28), and use of similar forms of the zinc metal filter media to that disclosed in the instant application, for instance use of zinc or other metals such as copper, having known galvanic or sacrificial properties, and in optionally particulate form, is disclosed by Koehler at column 10, lines 50-58.

For claims 2,5, and 10, zinc material is disclosed at column 10, line 53 of Koehler.

For claims 3,11 and 15 cellulosic material media is disclosed at column 13, lines 29-31 of Koehler.

For claims 12 and 16, synthetic or polymeric material for media layers is disclosed at column 13, line 29-31.

For claim 13, co-pleating is discussed in detail at column 20, lines 25-40 of Koehler.

Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koehler et al patent 5,664,628 in view of Underdown PG PUBS Document

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US2003/0079876, as applied to claims 1 and 6, and further in view of Whitlock patent 6,382,318 and/or Echols et al patent 6,415,509.

These claims further differ from Koehler in requiring perforations in filter media layer(s) to comprise slits or louvers. However, well filters having outer layers with slits are taught by Whitlock at column 12, lines 15-34 and by Echols at slits 44 at figures 2,3 and 5 and layer with louvers (slanted and shaped perforations in the form of gaps between sections of helical wound wrap) is taught by Whitlock at column 13, line 66-column 14, line 29. It would have been further obvious to one of ordinary skill in the art to have utilized layers having slitted or louvered perforations in the well filter of Koehler, as taught by Whitlock and/or Echols, in order to improve flow distribution from the well to the complete surface of the well filter and facilitate even flow distribution.

Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion


2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph W. Drodge whose telephone number is 571-272-1140. The examiner can normally be reached on 8:30-5:00 Monday-Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JWD
11/10/06


JOSEPH D. DODGE
PRIMARY EXAMINER